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APPLICATION NO.	FILED DATE	INVENTOR	ATTORNEY/DOCKET NO.	CLASSIFICATION
09/057,012	06/11/2001	Larry H. Glusker	HTL/03CP01	06/08

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

WOLACH, ROSEPH L

ARTICLE	PAPER NUMBER
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DATE MAILED 10/03/2001

17

Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879 312

Applicant(s)

GLIMCHER ET AL

Examiner

Joseph Wortach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In any event, however, a reply to this communication must be filed within SIX (6) MONTHS from the mailing date of this communication. If the period of reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. If no period of time is specified, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office after the expiration of this period for reply, even if timely filed, may reduce any claim to patent term adjustment under 37 CFR 1.136(d).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL** 2b) ☐ This action is non-final
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213

Disposition of Claims

- 4) ☐ Claim(s) 29-60 is/are pending in the application
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected
- 7) ☐ Claim(s) _____ is/are objected to
- 8) ☐ Claim(s) 29-60 are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f)
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))
- * See the attached detailed Office action for a list of the certified copies not received
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
- a) ☐ The translation of the foreign language provisional application has been received
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

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DETAILED ACTION

This application is a divisional application of 09 086,010, filed May 27, 1998, now patent 6,274,338, which is a continuation in part of 09,030,579, filed February 24, 1998, now abandoned.

Applicants' preliminary amendment filed June 12, 2001, paper number 3, has been received and entered. The specification has been amended. Claims 1-28 have been canceled. Claims 33-60 have been added. Claims 29-60 are pending and currently under examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 29, 30, 32, 33, 51-54, drawn to method to identify a compound that modulates the activity of a human c-Maf protein comprising evaluating the binding of a human c-Maf and a DNA molecule, classified in class 435, subclass 6; class 435, subclass 7.1; class 435, subclass 325; class 435, subclass 69.1.
- II. Claims 29, 31, 32, 34-54, 57-60, drawn to method to identify a compound that modulates the activity of a human c-Maf protein comprising evaluating the expression of a gene in an indicator cell, classified in class 435, subclass 6; class 435, subclass 7.1; class 435, subclass 325; class 435, subclass 69.1.

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III. Claims 55 and 56, drawn to a method to identify a protein which interacts with human c-Maf, classified in class 435, subclass 7.1.

Claims 29, 32, 51-54 are generic to both groups III and IV and will be examined to the extent they encompass the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different and separate methods requiring different method steps, and which result in the identification materially products. The methods of groups I and II require only the addition of a compound for testing, wherein the methods of group III require the construction and assay of a polynucleotide library of chimeric genes. Both methods of groups I and II require no knowledge of the compounds tested and are drawn generally to methods in which these compounds can be identified, however each groups uses a different indicator to test the compounds. Thus, each group requires different starting materials and different method steps to practice. The compounds used for each method, i.e. detecting, modulating and testing are not co-extensive in activities and would require a separate search and consideration. Further, each method results in a materially different outcome when practiced.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

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Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach

Richard C. [unclear]
DIRECTOR
PTO/PA/ [unclear]
[unclear] 7/2/00